11Fw 2143

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Lynh NGUYEN

Docket No: A8646

Appln. No.: 09/612,534

Group Art Unit: 2143

Confirmation No.: 9366

Examiner: Bunjob JAROENCHONWANIT

Filed: July 07, 2000

For: LIVE CONNECTION ENHANCEMENT FOR DATA SOURCE INTERFACE

RESPONSE TO NOTICE OF NON-RESPONSIVE AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Examiner states in a *Notice of Non-Responsive Amendment*, dated May 6, 2005, that the *Amendment* filed in the above-captioned Application on September 16, 2004, is not fully responsive to the *Office Action* dated June 16, 2004, allegedly because Applicant "fail [sic] to response [sic] to the "Double Patenting Ground of rejection, i.e., applicant defers further comment."

Applicant respectfully submits that the September 16, 2004 Amendment is fully responsive to each ground of rejection in the June 16, 2004 *Office Action*, including the Double Patenting Rejection to which the Examiner seems to refer. At the top of page 21 of the September 16, 2004 *Amendment*, Applicant addresses the "Rejection Under Obviousness-Type Double Patenting." As this rejection is provisional in nature, it is within Applicants' right not to address the merits of the provisional rejection, at least until one of the patent Applications upon which the rejection is based issues.

More specifically, the Examiner has provisionally rejected claims 1-3, 18-20 and 76-79 of the instant Application in view of various claims of co-pending Applications 09/750,432 and 09/750,475. The reason this rejection is provisional is that Applications 09/750,432 and 09/750,475 had not (and still have not) issued as U.S. Patents.

It is axiomatic that a provisional double patenting rejection requires no particular response from Applicants, as there are no patented claims to compare to the claims of the instant Application. Rather, a provisional double patenting rejection is designed simply to give Applicant notice of a possible future rejection, should the cited Applications actually issue as patents with claims similar to those in the cited Application. See, MPEP § 804(I)(B), which states that:

> the courts have sanctioned the practice of making applicant aware of [a] potential double patenting problem if one of the applications became a patent by permitting the examiner to make a "provisional" rejection on the ground of double patenting. In re Mott, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976); In re Wetterau, 356 F.2d 556, 148 USPQ 499 (CCPA 1966). The merits of such a provisional rejection can be addressed by both the applicant and the examiner without waiting for the first patent to issue.

Thus, it is clear that a provisional rejection only serves to place Applicant on notice that a "potential" problem exists, so that an Applicant and Examiner "can" address the merits of the double patenting rejection, if so desired. There is no requirement that such a provisional rejection be dealt with on the merits in any response by Applicants, until a patent issues. If the Examiner believes Applicant is required to address the merits of a provisional double patenting rejection, based solely on pending patent Applications, Applicant respectfully requests that the Examiner identify the authority imposing such a requirement.

Further, MPEP § 804(I)(B) clearly recognizes that the Examiner will continue to make a provisional rejection:

> unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

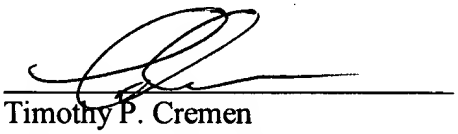
Thus, it is clearly recognized that a "provisional" rejection can be maintained through several actions, without Applicant addressing the merits of the rejection, until the Application is in condition for allowance. Then, it is the Examiner's responsibility to determine whether to make the "provisional " rejection an actual double patenting rejection.

Beyond the clear indications in the MPEP (as a practical matter), it is easy to see why no response to a "provisional" double patenting rejection is required, as neither of the cited Applications has issued as a U.S. patent, neither Application containts (at least at this time) any patented claims. Thus, it is impossible to determine with any particularity whether the claims of the instant Application would be obvious or not in view of patented claims, as no patented claims yet exist.

Further, as these Applications have not issued as U.S. patents, should Applicants wish to file a Terminal Disclaimer to obviate the rejection, it is impossible to know whether a Terminal Disclaimer will be necessary for the instant Application or for the cited Applications, as it is unclear which of the respective Applications will issue first.

Accordingly, Applicants respectfully request the withdrawal of the instant Notice of Non-Compliance. A short summary of the above points has been added to the Replacement Amendment submitted herewith.

Respectfully submitted,



SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Timothy P. Cremen
Registration No. 50,855

Date: June 6, 2005

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09/612,534	07/07/2000	Lynh Nguyen	ST9-99-134	9366

23373 7590 05/06/2005

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER	
JAROENCHONWANIT, BUNJOB	
ART UNIT	**PAPER NUMBER**
2143	

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED:

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

1. [X] The communication filed 9/16/04 is informal/non-responsive for the reason(s) checked below and should be corrected.
APPLICANT IS GIVEN ONE MONTH FROM THE DATE OF THIS LETTER OR UNTIL THE EXPIRATION OF THE PERIOD FOR RESPONSE SET IN THE LAST OFFICE ACTION (WHICHEVER IS LONGER) WITHIN WHICH TO CORRECT THE INFORMALITY.

   a. [ ] The amendment to claim(s) _____ , filed _____ , fails to comply with the provisions of 37 C.F.R. 1.121 and is accordingly held to be non-responsive. A supplemental paper correcting the informal portions and complying with the rule is required.

   b. [ ] The paper is unsigned. A duplicate paper or ratification, properly signed, is required.

   c. [ ] The paper is signed by _____ , who is not of record. A ratification or a new power of attorney with a ratification, or a duplicate paper signed by a person of record, is required.

   d. [ ] The communication is presented on paper which will not provide a permanent copy. A permanent copy, or a request that a permanent copy be made by the Office at applicant's expense, is required, see M.P.E.P. 714.07.

   e. [X] Other

2. [ ] In accordance with applicant's request, **THE PERIOD FOR RESPONSE FROM THE OFFICE ACTION DATED** _____
IS EXTENDED TO RUN _____ **MONTH(S).**
No further extension will be granted unless approved by the Commissioner. 37 C.F.R. 1.136 (b)

3. [ ] Receipt is acknowledged of papers submitted under 35 U.S.C. 119 which papers have been made of record in the file.

4. [ ] Other

See attachment.

NOTICE TO APPLICANT

1. The reply filed on 9/16/04 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): fail to response to the Double Patenting Ground of rejection, i.e., applicant defers further comment. See 37 CFR 1.111(b). Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).